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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,458	07/18/2000	Eiji Hayashi	862.C1958	8847

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EXAMINER

CHAU, MINH H

ART UNIT	PAPER NUMBER
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2854

21

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,458

Applicant(s)

HAYASHI, EIJI

Examiner

Minh H Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-58, 60-65, 67-72, 74-79 and 81-84 is/are rejected.
- 7) ☒ Claim(s) 59, 66, 73 and 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. **Claim 67** is objected to because of the following informalities: The dependency of claim 67 is improper, since claim 67 is referring to a method step. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
4. **Claims 57- 58, 60-62, 64-65, 67-69, 71-72, 74-76, 78-79 and 81-83** are rejected under 35 U.S.C. 102(e) as being anticipated by Ohtani (US # 6,144,818).

With respect to claims 57, 64, 71 and 78, Ohtani teach a host computer (2), a machine readable storage medium, a computer program and a method for communicating with a printer

device (1) having stapling function (col. 2, line 48) for binding together a plurality of sheets, generating a print data suited to the printer device, and transmitting the print data to the printer device, comprising acquisition means for acquiring paper feed tray information concerning the printer device from the printer device to which the print data is actually transmitted (col. 3) and display control means for controlling a screen display concerning the setting of staplable positions on the basis of the paper feed tray information acquired by the acquisition means from the printer device to allow the user from selecting the unstaplable positions on a printing paper in a paper feed tray of the printer device(see Fig. 1-9 and cols. 2-5 of Ohtani). It is also noted that the recitation "so that a user... said printer device" (the last two lines of claims 57, 64, 71 and 78) is for the intended use only, there is no structure or method step that generates an unstaplable positions on a display control means.

With respect to claims 58, 65, 72 and 79, see cols. 2-3 and Figs. 6-10 of Ohtani that teach the paper feed tray information relates to the size and the feeding direction of the printing paper or the R/non-R information of the printing paper and the display control means for displaying the setting of staplable positions on the basis of the R/non-R information and the paper size information. It is also noted that the recitation "so that the user ... printing paper" (last line of claims 58, 65, 72 and 79) is for the intended use only.

With respect to claims 60, 67, 74 and 81, see cols. 2-3 and Figs. 6-10 of Ohtani that teach the display control means control s the screen display concerning the setting of staplable positions on the basis of the paper feed tray information acquired by the acquisition means. It is also noted that the recitation "so that the user ... unstaplable positions" (last line of claims 60, 67, 74 and 81) is for the intended use only.

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With respect to claims 61, 68, 75 and 82, see cols. 3-4 Ohtani that teach a size of the printing paper that has been actually located in the paper feed tray is determined on the basis of the paper feed tray information acquired by the acquisition means.

With respect to claims 62, 69, 76 and 83, see col. 3 Ohtani that teach the setting means or a manual setting means for setting a desired paper size or the R/non-R information concerning the printing paper by using a user interface and the acquisition means acquires the R/non-R information and the paper size information on the printing paper by the setting means or manual setting means as the paper feed tray information.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 63, 70, 77 and 84** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani as applied to claims 57, 64, 71 and 78 above, and in view of Kimoto et al. (US # 5,390,005).

With respect to claims 63, 70, 77 and 84, Ohtani teach all the limitation as explained above, except for the recitation of "paper feed tray information is set by using a control panel on the printer device".

Kimoto et al. teach an image-forming machine including paper feed tray information is set by using a control panel on the image-forming device (see Fig. 5 and col. 5, lines 59+ of Kimoto et al.).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device and method of Ohtani to including the paper feed tray information is set by using a control panel on the image-forming device as taught by Kimoto et al. so that to allow the user to select and set a kind of sheet and a sheet size that are actually loaded in the paper feed tray as the printing device.

Allowable Subject Matter

7. **Claims 59, 66, 73 and 80** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Claims 59, 66, 73 and 80 have been indicated for containing allowable subject matter because the prior art fails to teach the entire combination teach a host computer, a machine-readable storage medium, a computer program and a method for communicating with a printer device having stapling function for binding together a plurality of sheets including the display control means and the step of gradually decreasing the number of staplable positions which can be selected, when the stapling direction information are set after the paper size information and the R/non-R information are set.

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Response to Arguments

9. Applicant's arguments filed 09/22/03 have been fully considered but they are not persuasive.

With respect to new claims 57-84, Applicant's argument center around that the Ohtani reference does not teach or suggest the acquisition means or display control means as recited in claims 57, 64, 71 and 78. The Examiner respectfully disagrees with the Applicant's opinion because Ohtani teaches in cols. 2-3 and Fig. 6-9 that the host computer including acquisition means for acquiring paper feed tray information and display means that display a plurality of stapling patterns and unstapable positions on the basis of the paper feed tray information acquired by the acquisition means. In view of the teaching above, it is clear to one of skill in the art that Ohtani meet all the limitations as broadly recited in claims 57, 64, 71 and 78.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H Chau whose telephone number is (703) 305-0298. The examiner can normally be reached on M - TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MHC
October 19, 2003

